REGEIVED CENTRAL FAX CENTER NOV 1 0 2008

FAX TRANSMISSION

DATE:

November 10, 2008

PTO IDENTIFIER:

Application Number

10/557.283-Conf. #9024

Patent Number

Inventor:

Subroto Chatterjee et al.

MESSAGE TO:

US Patent and Trademark Office

FAX NUMBER:

(571) 273-8300

FROM:

EDWARDS ANGELL PALMER & DODGE LLP

Jonathan M. Sparks, Ph.D.

PHONE:

(617) 517-5543

Attorney Dkt, #:

61383(71699)

PAGES (Including Cover Sheet):

17

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Certificate of Transmission (1 page)

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ABGEIVED CENTRAL PAX CENTER NOV. 1 0 2008

PTO/SB/97 (09-04)
Approved for use through 07/31/2006, QMB 0651-0031
U. S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1996, no persons are required to respond to a collection of information unless it displays a valid OMB control number. Application No. (if known): 10/557,283 Attorney Docket No.: 61383(71699) Certificate of Transmission under 37 CFR 1.8 I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office. November 10, 2008 Date Jonathan M. Sparks, Ph.D. Typed or printed name of person signing Certificate 53,624 (617) 517-5543 Registration Number, if applicable Telephone Number Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper. Transmittal (1 page) Petition to Withdraw The Holding of Abandonment (3 pages) Appendix A (7 pages) Appendix B (2 pages) Appendix C (2 pages)

CENTRAL FAX CENTER NOV 10 2008

PTO/SB/21 (09-06) Approved for use through 10/31/2008. OMB 0651-0031

Under the Paperv	vork Reduction Act of 1995, no p	ersone are required to rea	U.S. Pat spond to a col	ent and Trade: action of Infor	mark (mation	Office; U.S. DEPARTMENT OF COMMERC! LUNIESE It displays a valid OMB control number
			Application	n Number	-10001	10/557,283-Conf. #9024
-	TRANSMITT	AL	Filing Dat	e		November 30, 2006
İ	FORM		First Nam	ed Inventor		Subroto Chatterjee
İ			Art Unit	·		N/A
(to be	used for all correspondence aft	et initial filing)	Examiner	Name	一	Not Yet Assigned
Total Num	ber of Pages In This Submi	ssion	Attorney (ocket Numi	oer	61383(71699)
	E	NCLOSURES	(Check a	I that app	oly)	
Fee Tran	smittal Form	Drawing(s)			ĺ	After Allowance Communication to TC
Fe	e Altached	Licensing-rela	ated Papers			Appeal Communication to Board of Appeals and Interferences
Amendm	ent/Reply	x Petition				Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
Afte	er Final	Petition to Co Provisional A				Proprietary information
Affi	davīts/declaration(s)	Power of Attorn Change of Cor	ney, Revoca respondenci	ion Address		Status Letter
Extension	of Time Request	Terminal Disc	laimer .			O(her Enclosure(s) (please identify below):
Express A	Abandonment Request	Request for F	Refund			pendix A (7 pages) pendix B (2 pages)
Informatio	n Disclosure Statement	CD, Number o	of CD(s)	·		pendix C (2 pages)
Certified (Copy of Priority (s)	Landsca	pe Table or	ÇD		
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Signature	EDWARDS ANGELL	PALMER & DOI	DGE LLP			
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Printed name	Jonathan M Sparks.	Ph.D.	· · ·			
Date	November 10, 2008			Reg. No.	53.	624

PECEIVED DENTRAL FAX GENTER NOV 1 0 2008

Docket No.: 61383(71699) (PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Provisional Application of: Subroto CHATTERJEE et al.

Application No.: 10/557,283

Filed: November 30, 2006

For: Apolipoprotein C-1 Induced Apoptosis

Confirmation No.: 9024

Art Unit: 1646

Examiner: Not Yet Assigned

Attention: Office of Initial Patent Examination Mail Stop Petitions Commissioner for Patents,

P.O. Box 1450.

Alexandria, VA 22313-1450

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT UNDER 37 C.F.R. 1.181

Sir:

This is a Petition under Rule 1.181 for withdrawal of the holding of abandonment in the above-captioned matter on the grounds that the Restriction Requirement allegedly mailed from the U.S Patent and Trademark Office on February 21, 2008, was never received by Applicant's undersigned representative.

STATEMENT OF FACTS

1. A Restriction Requirement, addressed to Edwards Angell Palmer & Dodge, LLP, the undersigned's firm, was allegedly mailed from the USPTO on February 21, 2008. This Restriction Requirement was not received by our office.

U.S. Application Number: 10/557,283 Response Date: November 10, 2008

Docket No.: 61383(71699)

2. On September 24, 2008, a Notice of Abandonment was mailed from the USPTO. This Notice was received by our Office on September 26, 2008. A copy of the Notice of Abandonment is attached hereto as Appendix A.

- 3. The Notice of Abandonment stated that the subject application was held to be abandoned for failure to respond to a Office Letter allegedly mailed from the U.S Patent and Trademark Office on February 21, 2008. A copy of the Restriction Requirement (printed from Public PAIR) is attached hereto as Appendix B.
- 4. Although the Restriction Requirement is correctly addressed to the undersigned's firm, I hereby state that this Notice was never received at this firm.
- 5. I hereby state that a search of the file jacket and docket records for the subject application in the offices of Edwards Angell Palmer & Dodge, LLP, indicates that the Restriction Requirement was never received. A copy of a docket printout for the subject application, covering the period from August 2004 until the present, is attached hereto as Appendix C. Had the Restriction Requirement been received, the docket printout would have included a deadline for response to the Restriction Requirement (e.g., a response due date of March 21, 2008, one month from the date of mailing of the Restriction Requirement). No such deadline for response (or any other deadline associated with the receipt of a Restriction Requirement) appears in the docket report.

RELIEF REQUESTED

Applicants respectfully request, based on the foregoing facts and statements and the following arguments, that the Commissioner withdraw the holding of abandonment and reinstate the subject application to pending status.

ARGUMENT

This Petition and the related enclosures are being filed within two (2) months of the mailing date of the Notice of Abandonment. Accordingly, this petition is believed to be timely filed pursuant to 37 C.F.R. 1.181(f).

U.S. Application Number: 10/557,283 Response Date: November 10, 2008

Docket No.: 61383(71699)

In the present case, Applicant has included the required statements by the practitioner, and provided appropriate supporting evidence, to establish non-receipt of the Office Communication (the Restriction Requirement) which formed the basis for the holding of abandonment. Accordingly, the present application should not have been considered to be abandoned, and Applicant requests that the application be restored to pending status.

REQUIRED FEE

There is no fee required for the submission of a Petition under Rule 181, and it is believed that no fee is due. However, if for any reason a fee is required for consideration of this Petition, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. 04-1105 under Order No.

61383(71699).

Dated: November 10, 2008

Jonathan M. Sparks, Ph.D. Registration No.: 53,624

EDWARDS ANGELL PALMER & DODGE

LLP

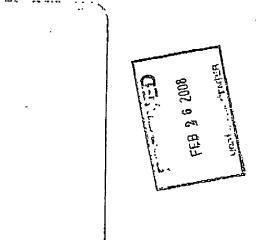
Respectfull

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(617) 517-5580

Attorneys/Agents For Applicant





UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address COMMISSIONER FOR PATENTS
P. Det 1650
Alexandra, Virginia 22513-1450

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO		
10/557,283	3 11/30/2006 Subroto Cha		61383(71699)			
49383 7590 02/21/2008 EDWARDS ANGELL PALMER & DODGE LLP Client: JHU P.O. BOX 55874 BOSTON, MA 02205		EXAMINER HOWARD, ZACHARY C				
						ART UNIT
					1646	
			T WIT TO T			
			MAIL DATE	DELIVERY MODE		
			02/21/2008	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

OL-326 (Rev. 08-06) Office Acuo	n Summary	Part of Paper No Mali Date 20080214
Notice of Draftsperson's Patent Drawing Review (PTO-948) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date Paper and Trademark Office	Paper No(s)/M	ail Date mal Patent Application
Notice of References Cited (PTO-892)	4) 🔲 Interview Sum	mary (PTO-413)
Attachment(s)		•
* See the attached detailed Office action for a list of	the certified copies not rec	ceived, .
application from the International Bureau ((PCT Rule 17 2/a))	
Copies of the priority	y documents have been re	ceived in this National Stage
 Certified copies of the priority documents 	have been received in App	lication No.
1. Certified copies of the priority documents	have been received	
12) Acknowledgment is made of a claim for foreign p a) All b) Some * c) None of:	priority under 35 U.S.C. § 1	19(a)-(d) or (f).
Priority under 35 U.S.C. § 119		
11) The oath or declaration is objected to by the Exa	miner. Note the attached C	Office Action or form PTO-152.
Replacement drawing sheet(s) including the correction	n is required if the drawing(s)	Is objected to Sec 37 CER 1 401/4
.Applicant may not request that any objection to the di	rawing(s) be held in abevance	See 37 CFR 1.85/a)
10)☐ The drawing(s) filed on is/are: a)☐ acce	pted or b) objected to by	the Examiner
9)☐ The specification is objected to by the Examiner.		
Application Papers		•
8) Claim(s) 1-11, 17, 29, 37 and 38 are subject to	restriction and/or election r	equirement.
7) Claim(s) is/are objected to.		
6) Claim(s) is/are rejected.		
4a) Of the above claim(s) is/are withdraw 5) Claim(s) is/are allowed.	n from consideration.	
4) Claim(s) <u>1-11,17,29,37 and 38</u> is/are pending in	n the application,	
Disposition of Claims		
closed in accordance with the practice under E	x parte Quayle, 1935 C.D.	11, 453 O.G. 213.
3) Since this application is in condition for allowan	ice except for formal matter	rs, prosecution as to the ments is
2a) ☐ This action is FINAL. 2b) ☑ This	action is non-final.	•
1) Responsive to communication(s) filed on 30 No.	ovember 2006	
Status		·
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 GPR 1.13 after SX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w. - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three mentions after the mailing earned patent turn adjustment. See 57 GPR 1.704(b).	36(a). In no event, however, may a rej	A FION. ply be limely filed MS from the mailing date of this communication.
1 - short with the phy		. '
- The MAILING DATE of this communication app	ZACHARY C: HOWARD	h the correspondence address
,	Examiner	Art Unit
Office Action Summary	10/557,283	CHATTERJEE ET AL.
	Application No.	Applicant(s)
	T	<u> </u>

Application/Control Number: 10/557,283

Art Unit: 1646

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DETAILED ACTION

Status of Application, Amendments and/or Claims

The preliminary amendment of 11/19/05 has been entered in full. Claims 4-9, 11, and 17 are amended. Claims 12-16, 18-28, 30-36 are canceled.

Claims 1-11, 17, 29, 37 and 38 are pending in the instant application.

Election/Restrictions

Restriction is required under 35 U.S.C, 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-11, drawn to a method of determining risk comprising measuring the level of ApoCI protein in a sample from a subject.

Group II, claim(s) 17 and 29, drawn to a method of identifying a test compound that binds to ApoC1 or inhibits ApoC1 activity.

Group III, claims 37 and 38, drawn to a method of treating a subject comprising administering an ApoCl inhibitor.

The inventions listed as Groups i-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Pursuant to 37 C.F.R. 1.475 (B-D), the ISA/US considers that where multiple products and/or processes are claimed, the main invention shall consist of the first invention of the category first mentioned in the claims and the first recited invention of each of the other categories related thereto. In the instant case, there are no product claims, only three categories of process claims.

Accordingly, the main invention consists of the first process of use of ApoCI protein (Group I), the second invention consists of the next process of use of ApoCI

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Art Unit: 1646

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protein (Group II), and third invention consists of a process of use of an ApoCI protein inhibitor.

Elections of species

If Group I is elected, in addition to the above restriction requirement, 3 elections of species are required as follows:

(I) Group I contains claims directed to more than one species of <u>patient sex</u>: (a) female or (b) male.

The claims are deemed to correspond to the species in the following manner:

- 1. Claim 5 corresponds to species (a).
- 2. Claims 1-4 and 6-11 are generic with respect to these species.
- (II) Group I contains claims directed to more than one species of <u>patient history</u>:
 (a) wherein the patient has been previously diagnosed with atherosclerosis and (b) wherein the patient has not been previously diagnosed with atherosclerosis;

The claims are deemed to correspond to the species in the following manner:

- 1. Claim 6 corresponds to species (a).
- 2. Claim 7 corresponds to species (b).
- 3. Claims 1-5 and 8-11 are generic with respect to these species.
- (III) Group I contains claims directed to more than one species of <u>patient age</u>: (a) infant and (b) not infant;
 - 1. Claims 9-11 corresponds to species (a).
 - Claims 1-8 are generic with respect to these species.

Each of these groups of species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Applicant is required, in reply to this action, to elect a single species of (I) patient sex; (II) patient history; and (III) patient age to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An

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Art Unit: 1646

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argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Risk for development of disease is often correlated with highly specific subsets of patients. Patient sex, history and age may independently contribute to a correlation between ApoCl protein level and risk of disease. Lack of unity is shown because the species of patients lack a common utility which is based upon a common structural feature which has been identified as the basis for that common utility.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary C. Howard whose telephone number is 571-272-2877. The examiner can normally be reached on M-F 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary B. Nickol can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Z. C. H./ Examiner, Art Unit 1646

> /<u>Elizabeth C. Kemmerer/</u> Primary Examiner, Art Unit 1646

Appendix B



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspio.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/557,283	11/30/2006	Subroto Chatterjce	61383(71699)	9024
49383 7590 09/24/2008 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205		EXAMINER HOWARD, ZACHARY C		
1646				
		•	MAIL DATE	DELIVERY MODE
			09/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Notice of Abandonment	10/557,283	CHATTERJEE ET AL.
Nonce of Abandonnient	Examiner	Art Unit
	ZACHARY C. HOWARD	1646
- The MAILING DATE of this communication		the correspondence address-
This application is abandoned in view of:		
Applicant's failure to timely file a proper reply to the (a) ☐ A reply was received on (with a Certificate period for reply (including a total extension of time (b) ☐ A proposed reply was received on but it does not consider the property of the constant of the period of the per	e of Mailing or Transmission dated _ e of month(s)) which expired), which is after the expiration of the
(A proper reply under 37 CFR 1.113 to a final reje application in condition for allowance; (2) a timely	ection consists only of: (1) a timely to	filed amondment which places the
Continued Examination (RCE) in compliance with (c) A reply was received on but it does not confinal rejection. See 37 CFR 1.85(a) and 1.111. (3)	nstitute à proper renty or a bone fo	de attempt at a proper reply, to the non-
(d) No reply has been received.	oee explanation in box / below).	
 Applicant's failure to timely pay the required issue fer from the mailing date of the Notice of Allowance (PTC) (a) The issue fee and publication fee, if applicable,	OL-85). was received on/with a C	ertificate of Mailing or Tennemication data.
(b) The submitted fee of \$ is insufficient. A bal	ance of \$ is due	
The issue fee required by 37 CFR 1.18 is \$		by 37 CED 4 48/J) :- #
(c) The issue fee and publication fee, if applicable, ha	as not been received.	by 57 G.R. 1.16(u), is 5
. Applicant's failure to timely file corrected drawings as Allowability (PTO-37).	required by, and within the three-m	onth period set in, the Notice of
(a) ☐ Proposed corrected drawings were received on _ after the expiration of the period for reply.	(with a Certificate of Mailing o	r Transmission dated), which is
(b) No corrected drawings have been received.		
. The letter of express abandonment which is signed by the applicants.	y the attorney or agent of record, th	e assignee of the entire interest, or all of
 The letter of express abandonment which is signed by 1.34(a)) upon the filing of a continuing application. 	y an attorney or agent (acting in a r	epresentative capacity under 37 CFR
 The decision by the Board of Patent Appeals and Inte of the decision has expired and there are no allowed 	erference rendered on and bricklins.	ecause the period for seeking court review
. The reason(s) below:		
	Ambien or or or or	
	/Elizabeth C. Kemme	
	Primary Examiner, Art	LUTIIL 1040
tilions to revive under 37 CFR 1.137(a) or (b), or requests to with himize any negative effects on patent term.	ndraw the holding of abandonment unde	er 37 CFR 1.181, should be promptly filed to
Patent and Trademark Office	ce of Abandonment	Part of Paper No. 20080922

Appendix C

Country Application

Thursday, October 09, 2008

Page: 1

Case Number: 61383

Country: US

SubCase:

Client: 71699

The Johns Hopkins University

United States of America

Case Type: PCT

Application Status: Published

Application Number: 10/557,283

Filing Date: 30-Nov-2006

Publication Number: US-2007-0178438-A1

Publication Date: 02-Aug-2007

Patent Number:

Issue Date:

Parent/PCT Number: PCT/US2004/016419

Parent/PCT Date: 24-May-2004

Parent Patent Number:

Parent Issue Date:

Tax Schedule: SE

Expiration Date: 24-May-2024 Patent Term Adjustment: 0

Confirmation Number: 9024

JMS

Attorney(s): PFC

Agent:

Client Ref. #: 4159

Agent Reference No.:

Client Pays:

Location: BOS

Tax Start Date: Alt File Ref #:

First Filing Date: 23-May-2003

Title: APOLIPOPROTEIN C-1 INDUCED APOPTOSIS

Remarks: ART UNIT: 1644

ASSIGNEE: The Johns Hopkins University

ADDITIONAL PRIORITY INFORMATION: 60/473,224 filed 05/23/2003

60/539,769 filed 1/28/2004 FOREIGN APPLICATIONS:

FOREIGN FILING LICENSE GRANTED: PROJECTED PUBLICATION DATE: 8/2/2007

ABANDONMENT INFORMATION:

9-24-08 - USPTO mails Notice of Abandonment because of "Applicant's failure

to timely file a proper reply to the Office letter mailed on 2-21-08" - sb

GENERAL INFORMATION:

5/7/2007- Filing Receipt received-mef

Inventors:

CHATTERJEE, Subroto KWITEROWICH, Peter O.

country Application		Thursday, Octo	ober 09, 2008 Pag	e:
List Of Actions				_
Action(s) Due	Due Date		Action Taken	
Application Sta Follow Up Date	01-Jul-1930	Due Date	01-Jan-1930	
Information Dis Follow Up Date	01-Jul-1930	Due Date	01-Jan-1930	
Information Disclosure Stmnt	24-Aug-2004	Final	01-Jan-1930	
Information Disclosure Strant	24-Nov-2004	Final	01-Jan-1930	
Application Status Check	24-Nov-2005	Due Date	01-Jan-1930	
Information Disclosure Stmnt	19-Feb-2006	Final	01-Jan-1930	
Information Disclosure Sunnt	19-May-2006	Final	01-Jan-1930	
Status Inquiry Due	16-Jul-2006	Due Date	01-Jan-1930	
Response to Missing Parts Due	30-Oct-2006	Due Date	30-Nov-2006	
Assignment Filed	30-Nov-2006	Due Date	30-Nov-2006	
Resp to Missing Parts 1st Ext	30-Nov-2006	Due Date	30-Nov-2006	
Resp to Missing Parts 2nd Ext	30-Dec-2006	Due Date	30-Nov-2006	
PTO Return Postcard	30-Jan-2007	Reminder	07-Dec-2006	
Resp Return Postcard Recd?	30-Jan-2007	Due Date	06-Dec-2006	
Resp to Missing Parts 3rd Ext	30-Jan-2007	Due Date	30-Nov-2006	
Information Disclosure Stunt	28-Feb-2007	Final	01-Jan-1930	
Resp to Missing Parts 4th Ext	28-Feb-2007	Due Date	30-Nov-2006	
Resp to Missing Parts in 2Wks	16-Mar-2007	Reminder	30-Nov-2006	
Resp to Missing Parts in 1Wk	23-Mar-2007	Reminder	30-Nov-2006	
Missing Parts Due 5th/Final Ex	30-Mar-2007	Final	30-Nov-2006	
Resp Filed/PTO Action Recd?	30-Apr-2007	Reminder	26-Sep-2008	
Application Status Check	19-May-2007	Due Date	01-Jan-1930	
Application Status Check	30-May-2008	Due Date	01-Jau-1930	
Pet to Withdr Holding Aband 1M	24-Oct-2008	Due Date		
Pet to Withdr Holding Aband 1W	17-Nov-2008	Reminder		
Pet to Withdr Holding Aband 3D	21-Nov-2008	Reminder		
Pet Withdr Holding Aband FINAL	24-Nov-2008	Final		
Resp Filed/PTO Follow Up Date	24-Mar-2009	Due Date	26-Sep-2008	

User ID: kawhalen

Date Created: 02-Dec-2005

Last Update: 06-Oct-2008